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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,211	03/23/2000	Atsushi Kawai	44376-029	1134
20277	7590	12/31/2003		
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
			EXAMINER LAMB, TWYLER MARIE	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 12/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/533,211

Applicant(s)

KAWAI ET AL.

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**Notice to Applicant (s)**

1. This action is responsive to the following communications: Response filed on 9/29/03.
2. This application has been reconsidered. Claims 1-13 are pending.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Freedman (US 4,839,829).

With regard to claim 1, Freedman discloses an image forming system (system 10, col 4, lines 25-41) comprising: a printing unit (second terminal 36 comprising hard copy printer 40, col 6, lines 37-42 and col 7, lines 51-61) for forming additional images (col 10, lines 11-14) in addition to document images (which reads on printing "work") (col 4, lines 25-41); an alteration means (programmed computer 20) for altering printing

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fees for the document images based on times required for forming the additional images (which reads on calculating the cost utilizing the alternative pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the graphic or the advertisement to be inserted the price would inherently include changes based on time required for forming the additional images.) (col 10, lines 15-19).

With regard to claim 2, Freedman also discloses in which said additional images are advertisements (which reads on calculating the cost utilizing the alternative pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the graphic or the advertisement to be inserted.) (col 10, lines 15-19).

With regard to claim 3, Freedman also discloses in which said printing unit forms additional images on the backside of sheets where the document images are formed (Figure 3A, col 11, lines 11-22).

With regard to claim 4, Freedman also discloses in which said printing unit forms additional images on sheets separate from the sheets where the document images are formed (Figure 3A, col 11, lines 11-26).

With regard to claim 5, Freedman also discloses further comprising: a determining means for determining images based on the times required for forming the additional images (which reads on calculating the cost utilizing the alternative pricing

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strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the graphic or the advertisement to be inserted the price would inherently include changes based on time required for forming the additional images.) (col 10, lines 15-19).

With regard to claim 6, Freedman also discloses in which said alteration means reduces the printing fees for document images when the times required for forming the additional images are longer (which reads on calculating the cost utilizing the alternative pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the graphic or the advertisement to be inserted the price would inherently include changes based on time required for forming the additional images.) (col 10, lines 15-19).

With regard to claim 7, Freedman also discloses further comprising: a display unit (display unit 14) for displaying information concerning the printing fees altered by said alteration means (which reads on providing the requester with information regarding various job costs) (col 10, lines 19-24).

With regard to claim 13, Freedman discloses an image forming system (system 10, col 4, lines 25-41) comprising: a printing unit (second terminal 36 comprising hard copy printer 40, col 6, lines 37-42 and col 7, lines 51-61) for forming additional images (col 10, lines 11-14) in addition to document images (which reads on printing "work") (col 4, lines 25-41); an alteration means (programmed computer 20) for altering printing

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fees for the document images when the additional images are formed (which reads on calculating the cost utilizing the alternative pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the graphic or the advertisement to be inserted.) (col 10, lines 15-19); and a display unit (display unit 14) for displaying information concerning the printing fees altered by said alteration means (which reads on providing the requester with information regarding various job costs) (col 10, lines 19-24).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman (US 4,839,829) in view of Markowitz (US 5,513,254).

With regard to claims 8, 10, 11 and 12, Freedman discloses an image forming system (system 10, col 4, lines 25-41) comprising: a printing unit (second terminal 36 comprising hard copy printer 40, col 6, lines 37-42 and col 7, lines 51-61) for forming additional images (col 10, lines 11-14) in addition to document images (which reads on printing "work") (col 4, lines 25-41); an alteration means (programmed computer 20) for altering printing fees for the document images when the additional images are formed

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(which reads on calculating the cost utilizing the alternative pricing strategies based upon usage of different printing or publishing equipment and based upon the parameters of differing printing facilities. The calculations would take in to consideration the development of the graphic or the advertisement to be inserted.) (col 10, lines 15-19).

Freedman does not clearly teach a memory unit that stores multiple additional images.

Markowitz discloses a telephone network carrying a facsimile transmission that modifies the users facsimile transmission by incorporating at least one advertisement with the users facsimile transmission that includes a memory unit (data bases 115 and 117) that stores multiple additional images (col 3, lines 49-63).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Freedman to include the memory unit that stores multiple additional images taught by Markowitz. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Freedman by the teaching of Markowitz to provide multiple advertisements that can be incorporated into the facsimile transmission causing a discount to be given {altering of fees} as taught by Markowitz in col 3, lines 49-63.

With regard to claim 9, Freedman as modified also includes in which said alteration means reduces printing fees for the document images when a combination of a color mode of the additional images is a combination which makes the times for forming the additional images longer (Figure 3A, col 11, lines 11-26).

***Response to Arguments***

7. Applicant's arguments filed 4/23/03 have been fully considered but they are not persuasive.

Applicant argues that the combination of Freedman (US 4,839,829) in view of Markowitz (US 5,513,254) does not teach an alteration means for altering fees based on selected additional images.

Markowitz teaches providing multiple advertisements stored in data bases 115 and 117 that can be incorporated into the facsimile transmission causing a discount to be given {altering of fees} in col 3, lines 49-63. This clearly reads on the claims limitations of an alteration means for altering fees based on selected additional images.

Applicant also argues that Freedman fails to disclose or suggest displaying information concerning altered fees on the display.

Freedman discloses a display unit (display unit 14) for providing the requester with information regarding various job costs in col 10, lines 19-24. This clearly reads on the claim limitation of displaying information concerning the printing fees altered by said alteration means.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6036 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be

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discussed at an interview; please label such communications "PROPOSED" or  
"DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

Twyler Lamb

A handwritten signature in black ink, appearing to be 'TL' or similar initials, written in a cursive style.

December 29, 2003